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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,375	12/19/2000	Samuel N. Zellner	00398; AT1-112	4937
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EXAMINER				
DURAN, ARTHUR D				
ART UNIT		PAPER NUMBER		
3682				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

09/740,375

Applicant(s)

ZELLNER ET AL.

Examiner

ARTHUR DURAN

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 21-30 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 21-30 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claims 21-30 have been examined.

Examiner Note

Examiner notes that the BPAI fully Affirmed the rejection of this case on 2/5/10. Hence, the prior rejections of the claims dated 4/19/2007 is affirmed as properly rejected. However, Applicant filed an RCE with claim amendments on 4/5/10.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/20/2011 has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21, and its dependents, is rejected under 35 U.S.C. 101 because upon consideration of all of the relevant factors with respect to the claim as a whole, claim 1 is held to claim an abstract idea, and is/are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

According to the July 2010 Guidelines, some of the factors weighing against patent eligibility under 35 U.S.C. 101 include:

- No machine/No transformation
- Insufficient machine/transformation
- Machine is merely acted upon
- Transformation involves only a change in position or location of article.

The Office has been using the machine-or-transformation test used by the Federal Circuit to evaluate whether a method claim qualifies as a statutory patent-eligible process. See Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. 101 dated August 24, 2009. The Supreme Court stated in *Bilski* that the machine-or-transformation test is a "useful and important clue" and "investigative tool" for determining whether some claimed methods are statutory processes, but it "is not the sole test for deciding whether an invention is a patent-eligible 'process.'"

According to the machine-and-transformation test, a process must (1) be tied to a particular machine or apparatus, or (2) particularly transform a particular article to a different state or thing (also referred to as the "machine-or-transformation test"). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876); *In re Bilski*, 88 USPQ2d 1385 (Fed Cir. 2008). Also see USPTO Memoranda, "Guidance for Examining Process Claims in view of *In re Bilski*," January 7, 2009 and "New Interim Patent Subject Matter Eligibility Examination Instructions," August 24, 2009. Both memoranda may be located on the USPTO website at: <http://www.uspto.gov/web/patents/rmemoranda.htm>.

Additionally, there are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patentable. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

It is further noted that mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 USC 101, as seen in the Board of Patent Appeals Informative Opinion Ex Parte Langemyr et al. (Appeal 2008-1495).

With respect to the rejected claims: applicant's method steps fail the first prong. Applicant's method steps also fail the second prong because they do not result in a transformation of a particular article to a different state or thing. Thus, the rejected claims are non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrey (2002/0102993) in view of Florance (20030229592) in view of Operowsky (20070027621).

Claim 21: Hendrey discloses:

Sending first information about a location of the user to a content provider that provides web content to the wireless communication device (Fig. 1; Fig. 2; Paragraphs [5, 53])

Sending an indication to the content provider when the location is continuously changing (Fig. 1; [38, 41]);

Searching a database of location specific advertisements and selecting a location specific advertisement relevant to the user (Fig. 1; [32, 33, 34]),

tracking a first one of a plurality of location-specific advertisements that is associated with the location of the user and tracking that the user is at a stable location that is not continuously changing ([45, 47, 48]).

Hendrey does not explicitly disclose that the advertisements are sent when the user's location is stable. However, Hendrey discloses tracking the user being both moving and stable (see above citations), that particular indications concerning advertisements can be made when the user's location is stable at certain areas ([47]), that the various features and embodiments of the Hendrey disclosure can be utilized for targeting advertisements ([53]), that there are many variations and factors for targeting a user ([32, 33, 34, 58]) and that there are many possible variations of the Hendrey disclosure ([66]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the information in Hendrey's Fig. 1, including whether the user is moving or the location is stable, can be utilized for targeting the user. One would have been motivated to do this in order to better target the

user with items of interest. Also, one would have been motivated to do this in order to better target users who are passing near stores or in buildings nearby stores or are proximate to stores and also to better utilize the time and location information for targeting users and for determining whether to send advertising and repeat advertising to users or not.

In further reference to independent claim 1, as noted on 6/19/2007, the prior art Hendrey renders obvious:

sending first information about a location of the user to a content provider that provides web content to the wireless communication device (Figure 1);

sending an indication to the content provider when the location is continuously changing (Figure 1; [47, 48]);

searching a first database containing a plurality of location-specific advertisements (Figure 1);

selecting a first one of the plurality of location-specific advertisements that is associated with the location of the user and is desired to be sent to the user at a stable location that is not continuously changing (Figure 1; [47, 48]); and

sending the first one of the plurality of location-specific advertisements to the wireless communication device over a communication network when the location is stable and not continuously changing (Figure 1; [47,48]).

Additionally, on 3/17/11 and 6/20/11, Applicant amended the independent claims:

"sending a pre-designated code from the service provider to the content server provider when the location is continuously changing;

searching a first database containing a plurality of location-specific advertisements, the database located on the content server, wherein receipt of the pre-designated code prevents the initiation of the searching by the content server;”.

Hendrey does not explicitly disclose sending a code when the location is changing so that the code prevents searching. However, Hendrey discloses that it is location information of the wireless device that is sent (Fig. 1) and sending location information from the wireless device from a service provider on a network to a content server (Fig. 1; [18-30]). And, as shown above, Hendrey discloses searching for ads to send to a moving user and determining if the user is moving or stationary to determine whether the ad is appropriate to send or not (Figs. 1, 2; and citations and explanation above). And, Hendrey discloses that a variety of factors can be used for determining targeting ([53, 32, 33, 34, 58]). Hendrey further discloses initiating the search for and providing of advertising when conditions are proper ([30, 32, 37]).

And, Florance discloses content and ads to a mobile user and that the user can use a wireless telephone or be in a vehicle (Fig. 2) and that speed of the moving user/user device should be taken account so that the direction, location, and speed of a user is taken into account when sending ads ([259]; “[259]... Thus, as the vehicle moves the system preferably takes speed and direction of travel into account when correlating data such as ads, promotions, tourist information, or other merchant or general interest information...”). And, Operowsky discloses content and ads to a mobile user (Figs. 2-5) and further discloses not presenting the ads if the user is moving or only if the user has paused (“[47]...Since some of the communications which can be

displayed using the present invention...might be distracting if presented while the car is in motion, by suitable programming the present invention could include controls which limit those messages to times when the vehicle is not in motion. Thus, detailed sightseeing information could be limited to those times when the vehicle is at rest (when the vehicle has pulled off to look at the landmarks) and e-mail and advertising might be displayed when the vehicle is stopped for a traffic signal or stopped due to rush hour congestion.”). And, Examiner interprets that the speed indicators in Florance like “80 miles an hour going South” ([259]) function as codes. These speed codes are interpreted in Florance by the server (Fig. 2) so that the “the system preferably takes speed and direction of travel into account when correlating data such as ads” ([259]) is possible. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Florance’s adjusting how or when ads are presented based on speed and Operowsky’s not sending ads to a mobile user while he is moving to Hendrey’s sending ads to a mobile user. One would have been motivated to do this in order to better provide ads at appropriate times (ad Hendrey states is desirable, [37]). Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Also, Examiner notes that Applicant's features were interpreted in light of Applicant's Specification and Applicant's Remarks dated 6/20/2011.

Claim 26: Hendrey further discloses utilizing a variety of position determining methods or technologies and also that user location information can be sent periodically ([44, 47]). Notice that the location is monitored over a period of time. Hence, the location is not continually monitored but monitored at different periods in time and, hence, periodically. Also, the utilization of different location determining methods or technologies allows to Hendrey to continually monitor location information, monitor location with very short (seconds or microseconds) periodical feedback of user location, or with longer periodical feedback of user location. Also, in further regards to claim 26, Hendrey discloses that it is location information of the wireless device that is sent (Fig. 1).

Claims 22-25, 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hendrey (2002/0102993) in view of Florance (20030229592) in view of Operowsky (20070027621) in view of Goldhaber (5794210).

Claim 22, 23, 27-30: Hendrey further discloses targeting users based parameters, filters, preferences, and profiles ([32, 35, 37]) and hiding certain information about users ([3]).

Hendrey does not explicitly disclose not transmitting an indication of the identity of the user. However, Goldhaber discloses activating and deactivating an identity-blocking option, the identity-blocking option to allow or prevent dissemination of an identity of the user to the content provider (6:61-7:7; 1:45- 13:10; 6:55-61). Goldhaber

further discloses the user logging in before being able to perform the user functions of providing or not providing identity information (Fig. 13, item 300; Fig. 13; Fig. 12, item 206; 7:27-31). The logging in with a passcode or password functions as the user enters a code on the device.

Goldhaber further discloses targeting users with content based on geographic areas (col 2, lines 27-35; col 15, lines 15-21) and that user geographic area information is known (col 13, lines 5-11).

Goldhaber discloses profiling a user, targeting content or advertising to a user based on known user information, maintaining user privacy, that user's can release user identifying information if the user so chooses (Abstract, second half; col 6, lines 22-45; col 7, lines 61-67; col 14, lines 10-17).

Goldhaber further discloses obtaining second information about the identity of the user for a fee (col 6, line 64-col 7, line 5; col 17, lines 20-26; col 14, lines 7-10).

Goldhaber further discloses the user indicating preferences for content to be received (Fig. 7; Fig. 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's user being able to control the user's profile to Hendrey's targeting a user based on a user profile. One would have been motivated to do this in order to better send content of interest to the user.

Claims 24, 25: In regards to claims 24, 25, Hendrey discloses that the user can be tracked as to being home or at work and that this indicates information relative to

advertisements ([47]) and that the user can be targeted based on profile or preference or other information (see citations in preceding claims).

Hendrey does not explicitly disclose that the user can indicated geographic areas to receive or not receive content.

However, Goldhaber discloses that the user can indicate a criteria that is to be utilized for delivering content and/or a criteria that is to be used to prevent certain content from being delivered (Fig. 10, item 124; col 6, lines 45-61). Notice that the profile includes items to send and/or not to send and that the user can edit the profile at any time and in any manner.

Goldhaber further discloses that different servers can serve different geographic areas as well as a variety of other interest areas (col 15, lines 17-31) and that the user can indicate as interested or not interested the different interest areas of the different servers (Fig. 10).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Goldhaber's indicating whether to receive content or not based on different criteria and geographic area as a criteria to Hendrey's particular location relative advertisements and targeting a user based on a variety of criteria. One would have been motivated to do this in order to better present content of interest to the user.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Note the addition of Florance and Operowsky to a 103 rejection above.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

aa) Note the prior rejections with Goldhaber and features like an identity blocking option;

a) The following prior discloses features relevant to not sending ads when a user device location is continuously changing or based on speed: Cohen 6060993 at det14; Florance 20030229592 at 259; Johnson 20100131584 at 634; Hoffberg 20070063875

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ARTHUR DURAN whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Namrata Boveja can be reached on (571) 272-8105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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9/19/12